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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,132	06/09/2005	Toshiyuki Kawaguchi	P/2850-109	2257
2352 7590 04/25/2008 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER				
HARRIS, GARY D				
ART UNIT		PAPER NUMBER		
1794				
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04/25/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/538,132

**Applicant(s)**

KAWAGUCHI ET AL.

**Examiner**

GARY D. HARRIS

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 April 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3 and 5-14 is/are pending in the application.  
4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 3, 5-7, 13-14 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 09 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date 1/25/08  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The office action acknowledges the receipt of Applicant's Request for Continued Examination filed on 4/7/2008.

Claims 1, 3 and 5-14 are pending and are examined in the instant application.

### ***Response to Arguments***

Applicant's arguments filed 4/7/2008 have been fully considered but they are not persuasive. Applicant argues that the Senda et al. adhesive component allows for attachment of the electromagnetic noise filter tape and therefore is not equivalent to the binding agent. However, examiner interprets that the adhesive is capable as acting as a binding agent and has inherent electromagnetic wave absorbing properties that would have been obvious to one skilled in the art. Examiner has applied an additional reference that further teaches the elastomeric and polymeric materials claimed.

Accordingly, this rejection is maintained.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Atoms of magnetic material being separated by a distance of less than 10 nm are not disclosed in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 13 & 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "complicated" in claims is a relative term which renders the claim indefinite. The term "complicated" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "complicated" heterogeneous structure could be any heterogeneous structure.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Senda et al. US 5,990,417.

As to Claim 1, Senda et al. '417 discloses an electromagnetic noise absorbing material and relationship of relative magnetic permeability (Col. 1, Line 24-34) and further discloses an imaginary part of a relative magnetic permeability more than 102 in the band of a few hundred MHz (Col. 24, Line 62-65). Senda et al. '417 does not disclose the imaginary part H of a complex magnetic permeability at 8 GHz higher than the imaginary part L of a complex magnetic permeability at 5 GHz. However, these properties are inherent because the applicants and the inventors teach virtually identical structures with similar materials. The physical properties of similar materials will inherently be similar. The burden of proof is shifted to the applicant to show the prior art properties are different from those claimed. See *In re Fitzgerald*, 619 F. 2d 67, 205 USPQ 594 (CCPA 1980). Senda et al. 417 does not disclose the binding agent is at least one resin or rubber selected from the group consisting of polyolefin resin, polyamide resin, polyester resin, polyether resin, polyketone resin, polyurethane resin, polysiloxane resin, phenol resin, epoxy resin, acrylic resin, polyacrylate resin, natural

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robber, isoprene rubber, butadiene rubber, styrene butadiene rubber, butyl rubber, ethylene propylene rubber, and urethane rubber. However, Sakura discloses an electromagnetic noise suppressor material and the use of polyurethane rubber used in a three layer structure (Column 10, 11, Line 55-67, 40-45 & Table 2 respectively) to allow for flexibility. It would have been obvious to one skilled in the art to utilize a polyurethane rubber in the Senda et al. '417 invention in order to enhance flexibility.

As to Claim 3, Senda et al. '417 discloses different manufacturing methods for depositing the magnetic material including physical vapor deposition (Col. 11, Line 51-52).

As to Claim 5, 6 & 7, Senda et al. '417 discloses the use of phenol resins, epoxy resins, (applicants hardening resins) vinyl resins, acrylate resins, or synthetic rubber (applicants resin or rubber) (Col. 15, Line 24-25).

As to Claim 13 & 14, Senda et al. '417 illustrates a relationship between relative permeability and frequency that would include frequencies in the GHz scale (see figure 37-38) the heterogeneous structure where the binding agent and a magnetic material are integrated on the nm scale would read on any magnetic material in contact with any heterogeneous material. The spacing distance of less than 10nm as claimed would be inherently met by Senda et al. '417. It has been held that where claimed and prior art products are identical or substantially identical, or are produced by identical or

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substantially identical processes, the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess characteristics of claimed products where the rejection is based on inherency under 35 USC §102 or on prima facie obviousness under 35 USC §103, jointly or alternatively. *In re Best, Bolton, and Shaw*, 195 USPQ 430. (CCPA 1977).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GARY D. HARRIS whose telephone number is (571)272-6508. The examiner can normally be reached on 8AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith D. Hendricks can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Holly Rickman/  
Primary Examiner, Art Unit 1794  
For Gary Harris